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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/532,330	04/22/2005	Jean-Louis Assie	4011/009	1760
170. 7590. 05/27/2009 RICHARD M. GOLDBERG 25 EAST SALEM STREET SUITE 419 HACKENSACK, NJ 07601				
EXAMINER				
PICKETT, JOHN G				
ART UNIT		PAPER NUMBER		
3728				
MAIL DATE		DELIVERY MODE		
05/27/2009		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

**Application No.**

10/532,330

**Applicant(s)**

ASSIE ET AL.

**Examiner**

J. Gregory Pickett

**Art Unit**

3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 15 May 2009.  
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.  
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 3-13 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.  
6) ☒ Claim(s) 1 and 3-13 is/are rejected.  
7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.  
8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.  
10) ☒ The drawing(s) filed on 22 April 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).  
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☒ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)  
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3) ☐ Information Disclosure Statement(s) (PTO/S508)  
Paper No(s)/Mail Date \_\_\_\_\_  
4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_  
5) ☐ Notice of Informal Patent Application  
6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 15 April 2009 has been entered.

Claims 1 and 3-13 are pending in the application. Claim 2 has been canceled. Claims 12 and 13 are new.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Claim Rejections - 35 USC § 103***

2. Claims 1, 3, 5-8, and 11-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mason (US 4,372,098) in view of Gruenbacher et al (US 6,547,468).

1, 12: Mason discloses a single-use packaging 10 comprising a protective cover made of two separable parts 12 & 14 of leak-proof material (Col. 3:39-41). Mason discloses an applicator 20 impregnated with a dose of substance (e.g. Col. 3:7-12) for application to the skin of a user (Figure 6) and fixed on an inside face of the cover part 12 (e.g. Col. 3:3-7), but does not disclose the applicator as a pouch with breakable blister.

Gruenbacher teaches an applicator comprising a pouch 10 with a first part 25 a second part 15 that is an applicator, and blister 12 housed within the parts of the pouch for the controlled release of the substance (see for example Col. 2:56-65). It would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the applicator pad of Mason with the applicator pouch of Gruenbacher in order to provide controlled release of the substance.

3: Gruenbacher discloses a pouch with a first part of flexible material 25 and a second part of flexible, porous material 15 united by closed junction 13/16 with blister 12 held captive between the parts. Mason teaches the applicator fixed to the inside face of cover part 12. To enable application of the substance, one of ordinary skill in the art would have found it obvious to mount the impermeable first part 25 of Gruenbacher to the inside face of Mason.

5-7 and 11: Mason teaches closed outline junction line 24 surrounding the applicator in an area significantly greater than the applicator area 20, which is substantially centered. Outline junction permits peelable separation and is a heat seal or adhesive (e.g. Col. 3:53-58). It would have been obvious to one of ordinary skill in the art to maintain this arrangement when the applicator pad 20 of Mason is replaced with pouch 10 of Gruenbacher.

8: Mason discloses pull-tabs 22.

13: Applicator 19 of Gruenbacher has a convex, rounded shape.

3. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Mason-Gruenbacher as applied to claim 3 above, and further in view of Kerch et al (US 4,762,124).

Mason-Gruenbacher as applied to claim 3 above, discloses the claimed invention except for the cotton wool inside the pouch.

Kerch teaches the provision of cotton wool 20 inside an applicator 10 with a permeable membrane 22 for the purpose of retaining large quantities of liquid in measured amounts (see for example Col. 4, lines 42-44). It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide cotton wool inside the pouch of Mason-Gruenbacher in order to retain large quantities of liquid in measured amounts.

4. Claims 9 and 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mason-Gruenbacher as applied to claim 1 above, and further in view of Fleury (US 6,695,515) and Frank (US 5,511,689).

Mason-Gruenbacher, as applied to claim 1 above, discloses the claimed invention except for the adhesive dressing.

Fleury suggests the provision of an adhesive dressing D on an applicator package for covering a wound after it has been disinfected (see for example Col. 2, lines 16-18).

Frank teaches an adhesive dressing 1 and cover 4 applicable to the external surface of a film 6 with the outside surface of dressing 1 weakly secured to an inside

face of cover 4; cover 4 is affixed to mounting film 6. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide an adhesive dressing as taught by Frank to a package of Mason-Gruenbacher for covering a wound after it has been disinfected as suggested by Fleury.

### ***Response to Arguments***

5. Applicant's arguments filed 15 April 2009 have been fully considered but are not persuasive.

Initially it is noted that the reference Smith et al has not been cited in the above rejections and arguments to its teachings are not on point. However, even assuming, *arguendo*, that the teachings are relevant, they are not deemed to be persuasive. While a breakable blister may render the Smith reference unsuitable, there is absolutely no language in Mason that would indicate that a breakable blister would also render it unsuitable. "We will not read into a reference a teaching away from a process where no such language exists." *DyStar Textilfarben GmbH & Co. DeutschlandKG v. C.H. Patrick Co.*, 464 F.3d 1356, 1364 (Fed. Cir. 2006). Further, Smith is formed from a flaccid, flat material, whereas Mason uses a formed shape. One of ordinary skill in the art would understand the shape of Mason to be more structurally resilient and resistant to crushing. Since the two references differ structurally, the teachings of the Smith reference need not be applied to the Mason reference.

The arguments that the junction line 24 of Mason is not "significantly greater" also fail to be persuasive. Applicant's specification does not define the term "significant"

as anything other than the plain meaning of the term. Any appreciable size difference can be considered "significant" and read on the claim term. In accordance with MPEP 2111.01, during examination, the claims must be interpreted as broadly as their terms reasonably allow. *In re American Academy of Science Tech Center*, 367 F.3d 1359, 1369, 70 USPQ2d 1827, 1834 (Fed. Cir. 2004). Applicant always has the opportunity to amend the claims during prosecution, and broad interpretation by the examiner reduces the possibility that the claim, once issued, will be interpreted more broadly than is justified. *In re Prater*, 415 F.2d 1393, 1404-05, 162 USPQ 541, 550-51 (CCPA 1969).

The arguments against Gruenbacher are unpersuasive since applicant is arguing significantly more than claimed. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Applicant's citations from Gruenbacher are located in the background of the invention and discuss the problems with the prior art and not the solution provided for by Gruenbacher.

Further, the cost or complexity of the combination is irrelevant to obviousness. The mere facts that the prior art may be more costly or more complicated to produce does not somehow render their teachings irrelevant or unobvious. The proper inquiry is "whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination," not whether there is something in the prior art as a whole to suggest that the combination is the most desirable combination available." *In re Fulton*, 391 F.3d 1195, 73 USPQ2d 1141 (Fed. Cir. 2004)

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Gregory Pickett whose telephone number is 571-272-4560. The examiner can normally be reached on Mon-Fri, 11:30 AM - 8:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/J. Gregory Pickett/  
Primary Examiner, Art Unit 3728